

REMARKS/ARGUMENTS

The present amendment is submitted in response to the Office Action dated April 25, 2005, which set a three-month period for response. Filed herewith is a Request for a One-month Extension of Time, making this amendment due by August 25, 2005.

Claims 14-25 are pending in the application.

In the Office Action, claims 14-25 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claim 22 was objected to for an informality. Claims 14-28, 20, and 22-25 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,809,417 to Normann, Jr. Claims 19 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Normann, Jr.

Turning first to the objection to claim 22, the Applicants believe that the Examiner has misread this claim. The gemstone has as a visible surface "one or more...", in other words, the visible surface has a visible surface in the form of "one or more...". In any event, the Applicants have amended claim 22 to more clearly define this limitation.

With regard to the rejection of the claims as being indefinite under Section 112, second paragraph, specifically, the phrase "said gemstone being suitable only for technical or industrial purposes", the Applicants respectfully disagree that this term is vague and indefinite.

Moreover, the Applicants strongly question why a rejection for indefinite language in the independent claim has only now been raised after this application has been pending for over 5 years and has been examined substantively by two different Examiners. In the multiple Office Actions issued in this case over those 5

years, the issue of indefiniteness as to the functional limitation “suitable only for technical or industrial purposes” has never been raised.

Indeed, in the recent telephone conferences with the Examiner regarding this application, the Examiner discussed this limitation in terms of its distinction over the prior art, but raised no possible objection as to indefiniteness of this phrase. Rather, the Examiner discussed the case primarily in terms of the “visible surface” limitation and the prior art.

As evidenced by the multiple arguments/amendments filed by the Applicants, this limitation has been relied on in the Applicants’ submissions as critical for distinguishing the present invention over the prior art. The term “suitable” alone is critical in this analysis: the word “suitable” means “appropriate” or “adequate”. As the Applicants have argued repeatedly, one object of the present invention is to customize natural or artificial gemstones, which are suitable only for industrial purposes, by means of appropriate technologies, so that they can be used in the field of jewelry. In other words, as discussed on page 1 of the present application, quite a number of diamonds that are prospected are not suitable for the manufacture of gemstones through grinding, because they either have too small a solidity or depth, or because of their color.

Contrary to the Examiner’s newly raised arguments, these types of gemstones normally are not suitable for use in jewelry, because, for example, they are of insufficient size, purity, or color. A large number of these gemstones cannot be processed further into jewelry items, which represents a considerable economic drawback, because the economic value of industrial gemstones naturally is much less than gemstones that are able to be used in jewelry.

However, as previously explained, with the present invention, a gemstone that is suitable originally only for industrial purposes nevertheless can be made into an appropriate ornamental stone by applying a material layer to a visible structure of the gemstone. The appropriate technical processes are used to provide structure to this material layer, resulting in a graphic pattern through interaction with the visible gemstone surface.

The Applicants further direct the Examiner's attention to MPEP 2173.05(g), which clearly states that this type of limitation is not necessarily vague and indefinite:

"A functional limitation is often used in association with an element, ingredient or step of a process to define a particular capability or purpose that is served by the recited element, ingredient, or step".

The objected-to language of claim 14 clearly falls under this definition. The Applicants therefore request withdrawal of the rejection under Section 112, second paragraph.

Looking now at the substantive rejections of the claims, the Applicants disagree that the Normann reference anticipates the subject matter of independent claim 14. The Examiner states in the Office Action that Normann discloses a gemstone body with a visible surface that supports a precious metal structured material layer.

However, claim 14 includes additional features that are not addressed by the Examiner in his analysis of the Normann reference. Specifically, claim 14 includes the features "and wherein at least one theme or image is formed from the structure of the material layer." This is achieved in that the material layer, as shown in Fig. 1 of the present application for example, is structured by using lithographic techniques

to ablate the material layer at a number of discontinuous portions, thus making the gemstone 3 discernable. From an observer's point of view, this results in a pixel pattern (as in a photograph) of a first color (gemstone 5) and of a second color (material layer-pixels 5).

An image, therefore, first arises from the structure of the material layer and its interaction with the gemstone.

In contrast, Figure 9 of Normann shows the generation of an object, or indicia, namely, a cross 66 from a gold layer by means of lithographic techniques. However, Normann fails to disclose in any manner the generation of an *image* by lithographic techniques, specifically, from the structure of the material layer.

The cross 66 achieves its visual effect solely from its outer shape without any interaction with the lower part 40 of the ornamental stone. Thus, even if the cross 66 were designated as an "image" (rather than an object produced by means of lithographic techniques, which it is), it still is not obtained from the structure of the material layer, as defined in claim 14 of the present application.

Normann also fails to disclose that the gemstone that is used is only suitable for technical or industrial applications, as defined in claim 14.

Normann discloses the preparation of an ornamental stone consisting of three components:

- a) a bottom section 14 (misleadingly referred to as a bottom layer);
- b) a top or cover section 12 (misleadingly designated as top layer 12);
- c) an indicia arranged between the bottom section and top section. The indicia 16 is primarily an object comparable to a coin or the like (see Normann, column 3, line 65, to column 4, line 11).

Finally, in the disclosure relating to Fig. 9, as noted above, Normann states that the indicia also can be produced by means of lithographic techniques. But as defined in both Normann claims as well as in the description, it is always necessary to provide a cover section 20, specifically in contrast to the present invention. In the process, the configuration of the cover section must complement that of the bottom section, thus necessitating a costly production process. After completion of the lithographic process, the cover and bottom section, as shown in Fig. 9 of Normann for example, are bonded to one another through the application of glue to the exposed surfaces surrounding the indicia/cross 66.

All of these steps are unnecessary in the present invention. A knowledgeable tradesperson presented with the invention's objective of processing gemstones, which are appropriate only for industrial purposes, in such a way as to make them suitable for use as jewelry, would not consult the Normann reference in the first place, because Normann fails to address these types of gemstones, nor does the reference specify the goal of refining these types of gemstones for use as jewelry.

Even if the practitioner consulted this reference, it would teach him/her only how to provide a gemstone with an indicia that is in itself ***non-structured***, and then how to produce a cover section complementary to the bottom section of the gemstone, and then finally, how to bond the cover and bottom sections together to encompass the indicia.

Normann provides the practitioner with no teaching or suggestion of shaping an image from the ***structure*** of the material layer. At best, the practitioner therefore would only be taught to divide a gemstone into a bottom and cover section and to arrange an indicia between these sections.

The Applicants furthermore submit that Normann is not a proper reference under 35 USC 102 pursuant to the guidelines set forth in the last paragraph of MPEP section 2131, where it is stated that "a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference", and that "the identical invention must be shown in as complete detail as is contained in the ... claim".

Here, Normann fails to disclose or even suggest the features of the present invention discussed above and provided in claim 14. Therefore, claims 14-25 are patentable over this reference.

In view of the foregoing discussion, the Applicants respectfully request reconsideration of the allowability of claims 14-25. In addition, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call from him to discuss any outstanding issues, and in particular any further amendments to the claims to bring the application into condition for allowance.

Respectfully submitted,



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